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OFFICE OF PETITIONS

In re Application of
Tom Tomlin
Application No. 10/046,948
Filed: January 14, 2002
Attorney Docket No. TOMT101

ON PETITION

This is a decision on the Petition for Revival of an Application Abandoned Unavoidably Under 37 CFR 1.137(a), filed November 20, 2003 (Certificate of Mailing dated November 17, 2003).

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The above-identified application became abandoned for failure to timely file a response to the non-final Office action mailed October 9, 2002. This Office action set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. No reply having been received, the above-identified application became abandoned on January 10, 2003. A Notice of Abandonment was mailed on May 15, 2003.

Consideration of petition under 1.137(a) (Unavoidable Delay)

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the

satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable: "The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."¹

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay.²

Petitioner asserts multiple reasons for the unavoidable abandonment of the application. First, petitioner argues that he received ineffective assistance of counsel from his prior attorney. Petitioner has supplied a copy of a letter from his prior attorney, dated December 9, 2002, transmitting a copy of the non-final Office action. The letter explained the process of filing a response to the non-final Office action, including the fee schedule for filing a response with an extension of time. In addition, the letter explained that if a response was not filed on or before April 9, 2003, the application would go abandoned.

Petitioner asserts that despite orally instructing his attorney to file an "appeal" to the non-final Office action, his attorney never did so. According to petitioner, his attorney never explained to him the process involved, or that his application would go abandoned.

The Patent and Trademark Office must rely upon the actions or inactions of an applicant's registered attorney or agent.

Petitioner also argues that his and his wife's medical and financial condition at the time prevented him from dealing with his prior counsel.

A showing of "unavoidable" delay based upon incapacitation must establish that petitioner's incapacitation was of such nature and degree as to render petitioner unable to conduct business transactions during the period between October 9, 2002 and April 9, 2003. Such a showing must be supported by a statement from

¹ In re Mattulath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

² See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

petitioner's treating physician, and such statement must provide the nature and degree of petitioner's incapacitation during the above-mentioned period.

Similarly, a showing of "unavoidable" delay based upon financial hardship must also be supported by documentation (e.g. copies of bankruptcy papers, income tax returns, W-2s, copies of bills, etc.).

If petitioner can not establish that the entire period of delay was unavoidable, petitioner may revive the above-identified application under the provisions of 37 CFR 1.137(b), unintentional delay. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to paragraph (d) of this section.

A copy of the form for a petition to revive due to unintentional delay is enclosed for petitioner's convenience.

The Revocation and Power of Attorney filed with the petition has been entered. Future correspondence concerning this application will be mailed to the new attorney of record at the above address.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: 703-746-3258
Office of Petitions
Attn: Cliff Congo

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0272.



Cliff Congo
Petitions Attorney
Office of Petitions

Enc: PTO/SB/64 (2 pages)